

**Remarks**

This Amendment is in response to the Office Action dated **May 22, 2009**. The Office Action rejected claims 1, 4, and 13 under 35 USC § 102 over Smith (US 6,258,064); rejected claim 14 under 35 USC § 103 over Smith; and rejected claim 17 under 35 USC § 103 over Smith in view of Mickley (WO 02/11807). These rejections are traversed.

New claims 21 and 22 are herein added. Support for these claims can be found in the Specification in paragraph [0040] and at least in Figure 3 of the published application.

In light of the following comments, Applicants request reconsideration.

**Claim Rejections – Section 102**

In the Office Action, claims 1, 4, and 13 were rejected under 35 USC § 102(b) over Smith. This rejection is traversed.

“A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference.” *Verdegal Bros., Inc. v. Union Oil Co.*, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987).

Smith fails to disclose all the elements claimed in independent claim 1. For example, Smith does not disclose “a needle ... extending from a proximal end of the catheter to a distal end of the catheter...” as is claimed.

As shown in figure 7 below (cited in the Office Action), Smith discloses “an inner tubular member 113 having a needle 116 at the distal end thereof and in fluid communication therewith, a flexible shaft 114 extending through the inner tubular member 113 and rigidly coupled to the needle 116, e.g., via a weld 117...” Column 8, lines 16-20. Smith further discloses a “threaded connection comprising a needle sleeve 140 about the needle 116, and a threaded cap 142 at the distal end of the sheath 112...,” column 8, lines 21-23, and a “proximal end 126 of the flexible shaft 114 extends through the first portion 131 of the bore 130...” Column 8, lines 43-45.

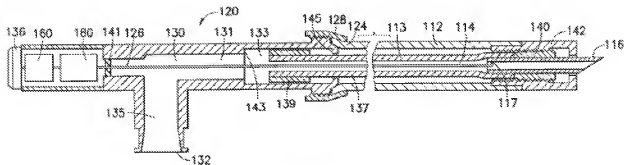


FIG. 7

The needle 116 of Smith does not extend from a proximal end of the catheter to a distal end of the catheter, as is claimed. Furthermore, assuming for the sake of argument only, that the needle sleeve 140 can be characterized as Applicants' claimed needle<sup>1</sup>, the needle sleeve 140 does not extend from a proximal end of the catheter to a distal end of the catheter. Consequently, Smith fails to disclose all the elements claimed in independent claim 1 and Applicants request withdrawal of the rejection.

Moreover, Applicants note that the claimed invention is directed to an injection catheter having a stop collar (e.g., 330) which is capable of sliding longitudinally within the catheter lumen, for example as shown below in figure 3 of Applicants Specification.

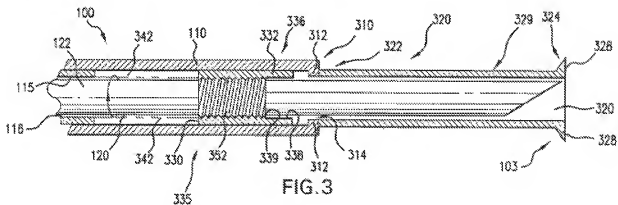


FIG. 3

In contrast, the alleged "stop collar 140, 142" of the endoscopic needle device of Smith is not capable of sliding relative to the sheath 112. Instead, the alleged stop collar of

<sup>1</sup> The Office Action implicitly recognized that the needle sleeve 140 of Smith is not the claimed needle. In this regard, the Office Action asserted, "Applicant discloses in claim 1 that a first set of threads located on the needle can be interpreted two ways: a) the needle having a thread set formed within the needle wall or b) an element having thread set located on the needle." The Office Action pointed to the needle sleeve 140 as the "thread set located on the needle." Thus, the Office Action implicitly recognized that the needle sleeve 140 is not analogous to Applicants' claimed needle.

Smith is a “threaded cap” 142 that appears to be fixed relative to the sheath 112. Consequently, Applicants request withdrawal of the rejection.

With regard to dependent claim 4, the Office Action asserted on page 3 that Smith discloses “a plurality of grooves 133 in an inner surface of the first elongated shaft to slidably receive the plurality of outwardly extending longitudinal protrusions, col. 8, ll. 35-38.” Column 8, lines 35-38 of Smith states, “[t]he proximal end 137 of the inner tubular member 113 is optionally provided with a ferrule 139 which is sized to axially slide and rotate within the cavity 133 (and provide a fluid seal), but yet is unable to exit the cavity due to stops 143 and 145.” Thus, the ferrule 139 is permitted to slide and rotate.

Thus, Smith does not disclose an injection catheter wherein “a plurality of grooves in an inner surface of the first elongated shaft to slidably receive the plurality of outwardly extending longitudinal protrusions,” as is claimed in claim 4. Consequently, Applicants request withdrawal of the rejection.

With regard to dependent claim 13 and with further regard to dependent claim 4, these claims depend from claim 1. Thus, claims 4 and 13 are patentable for at least the reasons discussed with respect to claim 1 and Applicants request withdrawal of the rejection.

### **Claim Rejections – Section 103**

In the Office Action, claim 14 was rejected under 35 USC § 103 over Smith. As discussed above, Smith does not disclose, teach, or suggest all of the subject matter claimed in independent claim 1. Claim 14 depends from claim 1 and incorporates all of the subject matter of claim 1. Claim 14 is therefore patentable for at least the reasons discussed with respect to claim 1 and Applicants request withdrawal of the rejection.

In the Office Action, claim 17 was rejected under 35 USC § 103 over Smith in view of Mickley. Mickley does not remedy the deficiencies of Smith as discussed above with respect to claim 1. Consequently, Applicants request withdrawal of the rejection.

### **New Claims 21 and 22**

As noted above, claims 21 and 22 are herein added. Independent claim 21 recites,

in-part, a “stop collar being longitudinally slidable and rotationally fixed within the first elongated shaft...” The alleged “stop collar” of Smith does not appear to be longitudinally slidable and rotationally fixed. Consequently, Applicants request allowance of claims 21 and 22.

**Conclusion**

Based on at least the foregoing remarks, Applicants request withdrawal of the rejections and allowance of claims 1, 4, 13, 14, 17, and 21. Favorable consideration and prompt allowance of these claims is earnestly solicited.

Should the Examiner believe that anything further would be desirable in order to place this application in better condition for allowance the Examiner is invited to contact Applicants’ undersigned representative at the telephone number listed below.

Respectfully submitted,

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